UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,349	12/28/2000	Jeffrey S. Hamilton	T730-10	8813

27832	7590	01/13/2005

TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME
6206 KELLERS CHURCH ROAD
PIPERSVILLE, PA 18947

EXAMINER
MANNING, JOHN

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">

~~signature~~

Office Action Summary</td><td>Application No.</td><td>Applicant(s)</td><td></td></tr>
<tr><td>09/751,349</td><td>HAMILTON ET AL.</td><td></td></tr>
<tr><td>Examiner</td><td>Art Unit</td><td></td></tr>
<tr><td>John Manning</td><td>2614</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 20050106

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-14 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-9 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Tsuria in view of Freeman et al. (US Pat No 5,861,881).

In regard to claim 1, the Tsuria reference discloses a device for displaying an

alternate signal on a screen of a video display device during a tune operation. The

claimed limitation of "a memory for storing one or more local signals" is met by the

memory unit 30 of Figure 1. "The advertisement data is processed by processor 28 and

stored in memory unit 30" (Col 3, Lines 60-61). The claimed limitation of "a processor

for recognizing the delay period associated with the channel change command from the

viewing stream to the requested stream" is met by processor 28 of Figure 1. The

claimed limitation of "a signal insertion module, coupled to the memory and the

processor, for retrieving a local signal from the memory and for inserting the local signal

in the delay period" is also met by processor 28 of Figure 1. "During zapping periods,

processor 28 is operable to retrieve the advertisement data from memory 30 and to

provide it, via D/A 26, to combiner and amplifier 32 for displaying the advertisement

data on television 14" (Col 3, Lines 61-65). As to the limitation that "the local signal is

inserted at a predetermined point to provide a seamless transition from the viewing

stream to the requested stream including the local signal", Tsuria is silent with respect

to the seamless transition.   Freeman teaches a seamless transition between two

streams so as to make the segue between the streams aesthetically pleasing. "FIG. 6

shows an embodiment which allows for a seamless video switch between two or more

separate digital video signals. As shown in FIG. 6, a CPU 108 is connected to an RF

demodulator 102 and digital demultiplexer 106. The CPU 108 directs demodulation and

demultiplexing of the proper channel and data stream to obtain the correct video signal.

Preferably, switches occur at an "I" frame if MPEG2 compression is used" (Col 7, Line

49-56). Consequently, it would have been obvious to one of ordinary skill in the art to

implement Tsuria with seamless transition between two streams so as to make the

segue between the streams aesthetically pleasing.

In regard to claim 2, Tsuria discloses the use of targeted advertisements. The

displayed advertisements are associated with the channel the use is tuned to. The

"separate advertisements are associated with separate channels. An advertisement is

displayed on television 14 only between the times a subscriber changes his selection

from a previously selected channel which he is currently viewing and the time the next

selected channel is displayed on television 14" (Col 3, Lines 66-67; Col 4, Lines 1-4).

In regard to claim 3, Tsuria discloses that the "local signal" is an audio signal.

The "CATV source 15 is operable to transmit advertisement data, preferably in the form

of slides accompanied by voice data" (Col 3, Lines 55-57), where the voice data is

clearly an audio signal.

In regard to claim 4, Tsuria discloses that the "local signal" is a graphics signal.

The "CATV source 15 is operable to transmit advertisement data, preferably in the form

of slides accompanied by voice data" (Col 3, Lines 55-57), where the slides are clearly a

graphics signal.

In regard to claim 5, Tsuria discloses a device for displaying an alternate signal

on a screen of a video display device during a tune operation for use in a digital CATV

system. Therefore, it is inherent that system has a demultiplexer for recalculating a new

program stream based on the channel change command.

In regard to claim 6, the claimed method is met by Figure 1. The claimed step of

"recognizing the delay period associated with the execution of the channel change

command from the viewing stream to the requested stream" is carried out by processor

28 of Figure 1. The claimed steps of "transmitting a request for a local signal, wherein

the local signals are stored in memory" and "receiving a local signal in response to the

transmitted request" are met by processor 28 and memory unit 30 of Figure 1. The

claimed step of "inserting the local signal during the delay period" is met by Figure 1.

"During zapping periods, processor 28 is operable to retrieve the advertisement data

from memory 30 and to provide it, via D/A 26, to combiner and amplifier 32 for

displaying the advertisement data on television 14" (Col 3, Lines 61-65). As to the

limitation that "the local signal is inserted at a predetermined point to provide a

seamless transition from the viewing stream to the requested stream including the local

signal", Tsuria is silent with respect to the seamless transition. Freeman teaches a

seamless transition between two streams so as to make the segue between the

streams aesthetically pleasing. "FIG. 6 shows an embodiment which allows for a

seamless video switch between two or more separate digital video signals. As shown in

FIG. 6, a CPU 108 is connected to an RF demodulator 102 and digital demultiplexer

106. The CPU 108 directs demodulation and demultiplexing of the proper channel and

data stream to obtain the correct video signal. Preferably, switches occur at an "I" frame

if MPEG2 compression is used" (Col 7, Line 49-56). Consequently, it would have been

obvious to one of ordinary skill in the art to implement Tsuria with seamless transition

between two streams so as to make the segue between the streams aesthetically

pleasing.

In regard to claim 7, Tsuria discloses the use of targeted advertisements. The

displayed advertisements are associated with the channel the use is tuned to. The

"separate advertisements are associated with separate channels. An advertisement is

displayed on television 14 only between the times a subscriber changes his selection

from a previously selected channel which he is currently viewing and the time the next

selected channel is displayed on television 14" (Col 3, Lines 66-67; Col 4, Lines 1-4).

In regard to claim 8, Tsuria discloses that the "local signal" is an audio signal.

The "CATV source 15 is operable to transmit advertisement data, preferably in the form

of slides accompanied by voice data" (Col 3, Lines 55-57), where the voice data is

clearly an audio signal.

In regard to claim 9, Tsuria discloses that the "local signal" is a graphics signal. The "CATV source 15 is operable to transmit advertisement data, preferably in the form of slides accompanied by voice data" (Col 3, Lines 55-57), where the slides are clearly a graphics signal.

In regard to claim 12, Tsuria indicated that the disclosed system may also be used in an analog CATV system. And, the "CATV source 15 is operable to transmit advertisement data" (Col 3, Lines 55-56), which would be an analog TV channel.

In regard to claim 13, Freeman discloses locally stored MPEG stream.

In regard to claim 14, Tsuria discloses a device for displaying an alternate signal on a screen of a video display device during a tune operation for use in a digital CATV system. Therefore, it is inherent that system has a demultiplexer for recalculating a new program stream based on the channel change command.

Claim 15 is met by that discussed above for claim 1.

In regard to claim 16, as discussed above for claim 1, the predetermined point is at an I frame which is the beginning of a GOP. The beginning of one GOP is the end of another GOP.

Claim 17 is met by that discussed above for claim 1.

In regard to claim 18, as discussed above for claim 1, the predetermined point is at an I frame which is the beginning of a GOP. The beginning of one GOP is the end of another GOP.

4.   Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Tsuria in view of Freeman et al. and in further view of Zigmond et al. (US Pat No

6,698,020) .

In regard to claim 10, the combination of Tsuria and Freeman disclose a device

for displaying an alternate signal on a screen of a video display device during a tune

operation. The combined teaching fails to explicitly disclose that the "local signal" is an

HTML page. Zigmond et al. teaches the use of HTML as a local signal so as to provide

"advertisements originating from advertisers that traditionally have not had access to

television or advertising production resources for economic or other reasons" (Col 9,

Lines 15-18). The "advertisements delivered from ad source 62 are inexpensively

converted from traditionally non-video media. For example, text, graphics, pictures, or

audio from a computer generated document (i.e., an HTML page) is converted into a

video display such as a freeze-frame or slide show" (Col 9, Lines 8-14). Consequently,

it would have been clearly obvious to one of ordinary skill in the art to implement the

combined teaching with the use of HTML as a local signal so as to provide

"advertisements originating from advertisers that traditionally have not had access to

television or advertising production resources for economic or other reasons" (Col 9,

Lines 15-18).

In regard to claim 11, the combined teaching of claim 10 discloses a device for

displaying an alternate signal on a screen of a video display device during a tune

operation. The combined teaching fails to explicitly disclose that the "local signal" is a

Java application. However, the examiner takes OFFICIAL NOTICE that it is notoriously

well known in the art to use a Java application as a "local signal" so a to provide an

interactive advertisement. Consequently, it would have been clearly obvious to one of

ordinary skill in the art to implement the combined teaching with Java application as a

"local signal" so a to provide an interactive advertisement.

5.   Claims 19-28 and 31-34 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Tsuria in view of Grossman.

In regard to claim 19, the Tsuria reference discloses a device for displaying an

alternate signal on a screen of a video display device during a tune operation. The

claimed limitation of "a memory for storing one or more local signals" is met by the

memory unit 30 of Figure 1. "The advertisement data is processed by processor 28 and

stored in memory unit 30" (Col 3, Lines 60-61). The claimed limitation of "a processor

for recognizing the delay period associated with the channel change command" is met

by processor 28 of Figure 1. The claimed limitation of "a signal insertion module,

coupled to the memory and the processor, for retrieving a local signal from the memory"

is also met by processor 28 of Figure 1. "During zapping periods, processor 28 is

operable to retrieve the advertisement data from memory 30 and to provide it, via D/A

26, to combiner and amplifier 32 for displaying the advertisement data on television 14"

(Col 3, Lines 61-65). Tsuria is silent with respect to the limitation of "creating a second

delay period for inserting the local signal in the second delay period, wherein the

second delay period is longer than the inherent delay period". The Grossman et al.

reference teaches creating a second delay period for inserting the local signal in the

second delay period, wherein the second delay period is longer than the inherent delay

period so that the viewer may comprehend the image. "The duration selected is

programmed into subscriber units 24a-n and implemented by image display method 80

as previously described" (Col 5, Lines 54-56). Additionally, "since subliminal messages

are not permitted under FCC rules, the duration of the display of the visual image

should be in excess of at least fifty milliseconds, a commonly accepted limit for

subliminal messages" (Col 5, Lines 46-49). Consequently, it would have been obvious

to one of ordinary skill in the art to implement Tsuria with creating a second delay period

for inserting the local signal in the second delay period, wherein the second delay

period is longer than the inherent delay period so that the viewer may comprehend the

image

In regard to claim 20, Tsuria discloses the use of targeted advertisements. The

displayed advertisements are associated with the channel the use is tuned to. The

"separate advertisements are associated with separate channels. An advertisement is

displayed on television 14 only between the times a subscriber changes his selection

from a previously selected channel which he is currently viewing and the time the next

selected channel is displayed on television 14" (Col 3, Lines 66-67; Col 4, Lines 1-4).

In regard to claim 21, Tsuria discloses that the "local signal" is an audio signal.

The "CATV source 15 is operable to transmit advertisement data, preferably in the form

of slides accompanied by voice data" (Col 3, Lines 55-57), where the voice data is

clearly an audio signal.

In regard to claim 22, Tsuria discloses that the "local signal" is a graphics signal.

The "CATV source 15 is operable to transmit advertisement data, preferably in the form

of slides accompanied by voice data" (Col 3, Lines 55-57), where the slides are clearly a graphics signal.

In regard to claim 23, Tsuria discloses a device for displaying an alternate signal on a screen of a video display device during a tune operation for use in a digital CATV system. Therefore, it is inherent that system has a demultiplexer for recalculating a new program stream based on the channel change command.

In regard to claim 24, Grossman discloses that market considerations can determine the duration of the time interval. Additional advertisements are interpreted to be a market consideration. "In the preferred embodiment of the invention it is believed that a suitable duration for the interdisplay time interval can be between approximately thirty seconds and approximately fifty seconds, with an interval of approximately forty seconds being the most preferred. In practice, however, it is believed that market considerations will determine the duration of the interdisplay time interval" (Col 5, Lines 22-28).

In regard to claim 25, the claimed method is met by Figure 1. The claimed step of "recognizing the inherent delay period associated with the execution of the channel change command" is carried out by processor 28 of Figure 1. The claimed steps of "transmitting a request for a local signal, wherein the local signals are stored in memory" and "receiving a local signal in response to the transmitted request" are met by processor 28 and memory unit 30 of Figure 1. The claimed step of "inserting the local signal during the delay period" is met by Figure 1. "During zapping periods, processor 28 is operable to retrieve the advertisement data from memory 30 and to provide it, via

D/A 26, to combiner and amplifier 32 for displaying the advertisement data on television

14" (Col 3, Lines 61-65). Tsuria is silent with respect to the limitation of "creating a

second delay period which is longer than the inherent delay period". The Grossman et

al. reference teaches creating a second delay period, which is longer than the inherent

delay period so that the viewer may comprehend the image. "The duration selected is

programmed into subscriber units 24a-n and implemented by image display method 80

as previously described" (Col 5, Lines 54-56). Additionally, "since subliminal messages

are not permitted under FCC rules, the duration of the display of the visual image

should be in excess of at least fifty milliseconds, a commonly accepted limit for

subliminal messages" (Col 5, Lines 46-49). Consequently, it would have been obvious

to one of ordinary skill in the art to implement Tsuria with creating a second delay

period, which is longer than the inherent delay period so that the viewer may

comprehend the image.

In regard to claim 26, Tsuria discloses the use of targeted advertisements. The

displayed advertisements are associated with the channel the use is tuned to. The

"separate advertisements are associated with separate channels. An advertisement is

displayed on television 14 only between the times a subscriber changes his selection

from a previously selected channel which he is currently viewing and the time the next

selected channel is displayed on television 14" (Col 3, Lines 66-67; Col 4, Lines 1-4).

In regard to claim 27, Tsuria discloses that the "local signal" is an audio signal.

The "CATV source 15 is operable to transmit advertisement data, preferably in the form

of slides accompanied by voice data" (Col 3, Lines 55-57), where the voice data is clearly an audio signal.

In regard to claim 28, Tsuria discloses that the "local signal" is a graphics signal. The "CATV source 15 is operable to transmit advertisement data, preferably in the form of slides accompanied by voice data" (Col 3, Lines 55-57), where the slides are clearly a graphics signal.

In regard to claim 31, Tsuria indicated that the disclosed system may also be used in an analog CATV system. And, the "CATV source 15 is operable to transmit advertisement data" (Col 3, Lines 55-56), which would be an analog TV channel.

In regard to claim 32, Freeman discloses locally stored MPEG stream.

In regard to claim 33, Tsuria discloses a device for displaying an alternate signal on a screen of a video display device during a tune operation for use in a digital CATV system. Therefore, it is inherent that system has a demultiplexer for recalculating a new program stream based on the channel change command.

In regard to claim 34, Grossman discloses that market considerations can determine the duration of the time interval. Additional advertisements are interpreted to be a market consideration. "In the preferred embodiment of the invention it is believed that a suitable duration for the interdisplay time interval can be between approximately thirty seconds and approximately fifty seconds, with an interval of approximately forty seconds being the most preferred. In practice, however, it is believed that market considerations will determine the duration of the interdisplay time interval" (Col 5, Lines 22-28).

6.   Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Tsuria in view of Grossman et al. and in further view of Zigmond et al.

In regard to claim 29, the combination of Tsuria and Grossman disclose a device

for displaying an alternate signal on a screen of a video display device during a tune

operation. The combined teaching fails to explicitly disclose that the "local signal" is an

HTML page. Zigmond et al. teaches the use of HTML as a local signal so as to provide

"advertisements originating from advertisers that traditionally have not had access to

television or advertising production resources for economic or other reasons" (Col 9,

Lines 15-18). The "advertisements delivered from ad source 62 are inexpensively

converted from traditionally non-video media. For example, text, graphics, pictures, or

audio from a computer generated document (i.e., an HTML page) is converted into a

video display such as a freeze-frame or slide show" (Col 9, Lines 8-14). Consequently,

it would have been clearly obvious to one of ordinary skill in the art to implement the

combined teaching with the use of HTML as a local signal so as to provide

"advertisements originating from advertisers that traditionally have not had access to

television or advertising production resources for economic or other reasons" (Col 9,

Lines 15-18).

In regard to claim 30, the combined teaching of claim 10 discloses a device for

displaying an alternate signal on a screen of a video display device during a tune

operation. The combined teaching fails to explicitly disclose that the "local signal" is a

Java application. However, the examiner takes OFFICIAL NOTICE that it is notoriously

well known in the art to use a Java application as a "local signal" so a to provide an

interactive advertisement. Consequently, it would have been clearly obvious to one of

ordinary skill in the art to implement the combined teaching with Java application as a

"local signal" so a to provide an interactive advertisement.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to John Manning whose telephone number is 703-305-

0345. The examiner can normally be reached on M-F: 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John W Miller can be reached on 703-305-4795. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JM
January 10, 2005

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600